

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER GOLD

Appeal No. 1997-0380
Application No. 08/368,099¹

HEARD: October 6, 1999

Before McCandlish, Senior Administrative Patent Judge and
Abrams and GONZALES, Administrative Patent Judges

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claim 1, which is the sole claim pending in the

¹ Application for patent filed January 03, 1995.

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application.² We REVERSE.

The subject matter on appeal is directed to a screw head nail having a generally cylindrical and enlarged diameter nail head [26] with a frustoconical [30] defining an outwardly flared opening therethrough and which is aligned with a cylindrical bore [28] formed in the nail shank [22]. The cylindrical bore is provided to receive a conventional machine screw. The enlarged nail head is configured to prevent obstruction of the cylindrical bore upon hammering of the nail into a work piece.

A copy of the appealed claim is appended to the main brief (Paper No. 10).

The prior art references of record relied upon by the examiner in rejecting the appealed claim are:

Farrington	824,983	Jul. 03, 1906
Meyer	2,802,297	Aug. 13, 1957

The claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Farrington, alone, and over Meyer in

² Claim 1 was amended subsequent to the final rejection to include the subject matter of dependent claim 2.

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view of Farrington.

The full text of the examiner's rejections and the responses to the arguments presented by appellant appear in the answer (Paper No. 11, mailed August 20, 1996), while the complete

statement of appellant's arguments can be found in the main brief (Paper No. 10, filed July 26, 1996).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we conclude that the

§ 103 rejections cannot be sustained.

Considering first the § 103 rejection based on Farrington, alone, we find that Farrington discloses "a screw

which may be inserted in wood or other material in the usual manner, but which cannot be withdrawn without mutilation" (lines 11-14). Farrington illustrates two embodiments. The first embodiment shown in Figures 1 and 2, includes a screw body [a] provided with exterior screw threads [e] and a longitudinal socket [b] extending downwardly from the top of the screw body. The socket [b] is provided with interior screw threads [f] adapted to receive a false head [c] having a rounded top with a slot and a flat outer edge conforming to the flat outer edge of the top of the screw body. The second embodiment illustrated in Figures 3

and 4 is similar to the first embodiment, except the false head [k] has a flat top with a slot and a generally conical bottom and the upper end of the screw body is flared to conform to the conical shape of the false head.

The examiner admits that Farrington does not show a generally cylindrical head with an enlarged diameter relative to the nail shank and a frustoconical opening being recessed within the nail head (answer, page 3). However, it is the

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examiner's position that it would have been obvious "to provide the internally threaded bore of Figure 1 with a frustoconical opening in order to receive a screw with a frustoconical head as taught in Figure 4" (id.).

It is well settled that it is the teachings of the prior art taken as a whole which must provide the motivation or suggestion to combine the references. See Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) and Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 550-51 (Fed. Cir. 1985). It is apparent from a reading of Farrington that the embodiment shown in Figures 1 and 2 was never intended to be used with a false

head screw having a frustoconical head. Thus, the only suggestion for combining the different embodiments of the reference in the manner proposed by the examiner stems from hindsight knowledge derived solely from the appellant's disclosure. The use of hindsight knowledge to support a

conclusion of obviousness is, of course, impermissible. Therefore, we will not sustain the standing 35 U.S.C. § 103 rejection of the claim based on Farrington alone.

Turning next to the 35 U.S.C. § 103 rejection based on Meyer in view of Farrington, Meyer discloses an upholstered furniture tufting device comprising an elongated stud [10] having a disc-shaped head portion [12] and a shank portion [14] including a pointed tip [20]. The head has a well or recess [22] communicating with a tapped bore [24]. The device also includes a separate button [26] having a cylindrical head [28] and a threaded shank [30]. In use, the shank of stud [10] is inserted through the muslin-burlap covered stuffing material [36, 38, 40] and a lock plate [32] is applied to the exposed pointed tip [20] of stud shank [14]. Upholstery or dress covering [42] having a plurality of grommet-reinforced openings [44] is then applied over the furniture and the threaded shanks [30] of the buttons

[26] are passed through openings [46] into engagement with the

tapped bores [24] of studs [10]. The grommets [46] surrounding the openings [44] are received in the recesses [22] of the disc-shaped head portion [12].

As implicitly conceded by the examiner, Meyer does not teach or suggest a generally cylindrical head with an enlarged diameter relative to the shank portion and a frustoconical opening being recessed within the nail head. However, the examiner has concluded that

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the internally threaded bore of Meyer '297 with a frustoconical opening, as taught by Farrington '983, in order to receive a screw with a frustoconical head. The frustoconical opening would allow the head to sit within the opening to make the head of the screw as flush as possible to the surface of the furniture. The upholstery would be wedged between the frustoconical opening and the frustoconical head of the screw. (Answer, page 4)

We will not support the examiner's position. Here again, absent the appellant's own disclosure, we can think of no reason why one of ordinary skill in this art would have been motivated to combine the teachings of Meyer and Farrington in the manner that the examiner has proposed. The examiner apparently is proposing to extract from the teachings of Farrington the feature

of a frustoconical opening communicating with a threaded bore
(as

illustrated by Farrington in Fig. 4) and incorporate this feature into the elongated upholstery stud of Meyer, while at the same time retaining Meyer's disc-shaped head [12]. The examiner, however, may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. See Bausch & Lomb, Inc., v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987) and In re Kamm, 452 F.2d 1052, 1057, 172 USPQ 298, 301-02 (CCPA 1972). Here, Farrington does not teach or suggest forming a frustoconical opening in a cylindrical head. Instead, Farrington teaches a screw body [a] having a flared upper end [i] which forms a frustoconical opening for receiving the beveled section [n] of a flat head screw. Meyer teaches a disc-shaped head [12] having a centrally located opening communicating with a tapped bore [24]. There is simply

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nothing in the combined teachings of Meyer and Farrington which would fairly suggest providing the elongated stud of Meyer with a frustoconical opening as illustrated by Farrington in Figure 4 for the purpose of receiving a flat head screw and, at the same

time, discarding the flared end of the screw body illustrated by Farrington (which is provided by Farrington to form the frustoconical opening) and retaining the disc-shaped head [12] taught by Meyer.

From our perspective, the examiner has impermissibly relied upon the appellant's own teachings in arriving at a conclusion of obviousness. This being the case, we will not sustain the rejection of the claim under 35 U.S.C. § 103 based on the combined teachings of Meyer and Farrington.

In summary, both of the examiner's rejections of the claim under 35 U.S.C. § 103 are reversed.

REVERSED

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Administrative Patent Judge)	
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)	BOARD OF PATENT
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Administrative Patent Judge)	INTERFERENCES
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